

REMARKS

Reexamination and reconsideration in light of the foregoing amendment and following remarks is respectfully requested.

Claims 41, 42, 44, 46, 47 and 49-66 are pending in this application. Claims 1-40, 43, 45 and 48 have been canceled. Claim 36 has been canceled and represented as claim 49. Claims 19, 22-25 and 38 which were dependent on canceled claim 36 have been represented as claims 50-55, respectively, and made dependent on new claim 49. Claim 39 has been canceled and represented as claim 56. Claims 17, 18, 20, 21, 26-30, 35 and 40, which were dependent on canceled claim 10, claim 16 or claim 39 have been represented as claims 57-66, respectively, and made dependent on new claim 56. Claim 43 has been represented as new claims 67 and 68 while claim 45 has been represented as new claims 69 and 70. Claims 1-15 and 31-34 and 48 have been canceled subject to Applicants' right to file divisional patent applications on the non-elected inventions. No new matter has been added to the application by the amendments to the claims.

Claims 17-22, 25, 26, 35, 38, 43 and 45 have been objected to as having informalities. All of the claims have been canceled thereby rendering the objections moot as to these claims. Despite the fact that the objected to claims have been canceled, with respect to the Examiner's objection to the claims under 37 C.F.R. § 1.75(c), the claims have been rewritten and reordered to place them in "proper" dependent form. However, it is noted that 37 C.F.R. § 1.75 does not require that a dependent claim further limit the subject matter of a "previous" claim. The rule merely requires that the dependent claim limit "another claim or claims in the same application." However, in order to expedite prosecution of the application, the following changes have been

made to the claims to conform to the Examiner's requirement. Claim 36 has been canceled and represented as claim 49. Claims 19, 22-25 and 38, which were dependent on canceled claim 36, have been represented as claims 50-55, respectively, and made dependent on new claim 49. Claim 39 has been canceled and represented as claim 56. Claims 17, 18, 20, 21, 26-30, 35 and 40, which were dependent on either canceled claim 10, claim 16 or claim 39, have been represented as claims 57-66, respectively, and made dependent on new claim 56. Claim 43 has been represented as new claims 67 and 68 while claim 45 has been represented as new claims 69 and 70.

Claim 26 was rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. The rejected claim has been rejected thereby rendering the rejection moot.

Claims 17, 20, 35, 39, 40 and 44 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Hideg et al. Claims 17, 20, 35, 39 and 40 have been canceled thereby rendering the rejection as to these claims moot. As for claim 44, it has been amended to provide a proviso that when R^6 and R^7 are hydrogen or $-CH_2CH_3$, substituents R^1 , R^2 , R^3 and R^4 cannot be hydrogen. Therefore, the claim no longer includes within its scope the compound disclosed in Hideg et al. Accordingly, it is respectfully requested that the rejection of claim 44 be reconsidered and withdrawn.

Claims 17, 20, 21, 35, 39, 40 and 44 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Sawlewicz et al. Claims 17, 20, 21, 35, 39 and 40 have been canceled thereby rendering the rejection as to these claims moot. As for claim 44, it has been amended to provide a proviso that with the proviso that when R^6 and R^7 are hydrogen or $-CH_2CH_3$, substituents R^1 , R^2 , R^3 and R^4 cannot be hydrogen. Therefore, the claim no longer includes within its scope the

compound disclosed in Sawlewicz et al. Accordingly, it is respectfully requested that the rejection of claim 44 be reconsidered and withdrawn.

Claims 19, 21, 35, 36, 39 and 42 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Barton et al. (EP 448206). Claims 19, 21, 35, 36, 39 have been canceled thereby rendering the rejection as to these claims moot. As for claim 42, the rejection asserts that compound 73 in Table IV of the reference anticipates the claim because the tri-substituted phenyl ring at the R³ position is a protecting group. The tri-substituted phenyl in Compound 73 is identified in the reference as a 2-chloro-6-fluoro-(trifluoromethyl) phenoxy group. There is no disclosure that that the group is a protecting group to form a protected hydroxy. The rejection does not include any evidence nor has the Examiner presented any cogent scientific reasoning from the teaching of the reference that a person having ordinary skill in the art would have recognized the phenoxy group as a hydroxyl protecting group. Accordingly, the Examiner has failed to present a *prima facie* case of anticipation of claim 42 by Barton et al. It is respectfully requested that the rejection of claim 42 be reconsidered and withdrawn.

It is submitted that the claims 41, 42, 44, 46, 47 and 49-70 are patentable over the teachings of the prior art relied upon by the Examiner. Accordingly, favorable reconsideration of the claims is requested in light of the preceding amendments and remarks. Allowance of the claims is courteously solicited.

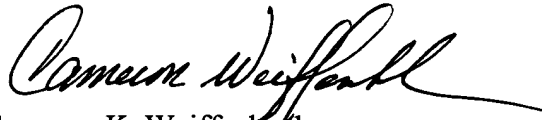
If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicants' attorney at the telephone number shown below.

Application No. 09/401,004

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due pursuant to 37 CFR § 1.17 and in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY, LLP

A handwritten signature in black ink, appearing to read "Cameron Weiffenbach", with a long, sweeping horizontal stroke at the end.

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